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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/674,962	09/30/2003	David F. Bantz	YOR920030325US1 (16872)	5304
23389 7590 07/13/2007 SCULLY SCOTT MURPHY & PRESSER, PC 400 GARDEN CITY PLAZA SUITE 300 GARDEN CITY, NY 11530			EXAMINER LIU, LIN	
			ART UNIT 2145	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/674,962

Applicant(s)

BANTZ ET AL.

Examiner

Lin Liu

Art Unit

2145

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date. _____   | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

1. This office action is responsive to communications filed on 09/30/2003.

Claims 1-35 are pending and have been examined.

2. New drawing sheets submitted on 12/08/2003 are considered.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. **Claims 31-35** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 31 recites the limitation "a program storage device readable by a machine ...", this program storage device is not defined on the specification.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. **Claims 1-35** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For claims 1, 18 and 31, recite the phrase: "... determining satisfaction of said switching criterion...", is indefinite and vague as what applicant refers to as. The other claims are dependent claims of claims 1, 18 and 31, thus they are rejected under the same reason.

***Claim Rejections - 35 USC § 101***

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. **Claims 18-35** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 18 is directed toward a system with means for functions, wherein means for establishing, means for monitoring and means for switching can all be implemented by software alone. Claims directed toward software alone refer to functional descriptive material, which is per se non-statutory. Claims 19-30 depend on claim 18, thus they are rejected under the same reason.

With regard to claim 31, the instant claim is directed toward a computer instructions stored on a machine readable storage device; this machine readable storage device is not defined on the specification, thus the machine readable storage device can be software per. se. Claims directed toward software alone refer to functional descriptive material, which is per se non-statutory. Claims 32-35 depend on claim 31, thus they are rejected under the same reason.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1, 2, 4, 6-10, 12-14, 17-21, 23-28, 31, 32 and 34 are rejected under 35 U.S.C. 102(e) as being anticipated by **Ishiyama et al. (Publication no.: US 2005/0102415 A1)**.

With respect to **claim 1**, Ishiyama teaches a method for real-time dynamic switching between a first service provider providing a service for users over a communications network and a second service provider (Ishiyama, fig. 1), said method comprising the steps of:

a) establishing switching criterion for deciding when to switch service provision between said first service provider and second service provider (Ishiyama, page 5, paragraph 62, noted the selection method for the source address of the ISP to be added to the header of the packet);

b) monitoring said communications network for determining satisfaction of said switching criterion (Ishiyama, page 5, paragraphs 64 and 68, noted that the router R1

monitors the connectivities with the ISPa and ISPb and checks if the condition is satisfied); and,

c) switching between first and second service provided over said communications network based on satisfaction of said switching criterion (Ishiyama, page 6, paragraphs 82 and 89-91, noted that when router R1 detects that the primary ISP is disconnected, it sends a message to the communication node N, and the communication node N generates the source address of the new ISP and attaches this address to the header of the packet).

With respect to **claim 2**, Ishiyama teaches the method of claim 1, further including the steps of:

maintaining state information associated with said user's use of said service provided by said first service provider (Ishiyama, page 4, paragraph 50, noted the ISP state management unit 34); and,

migrating any state information maintained up to the time of switching to said second service (Ishiyama, page 7, paragraph 104, noted that the connectivity maintains when switching over to the secondary ISP), wherein the switching occurs in a manner substantially transparent to the user (Ishiyama, page 7, paragraphs 103-105, noted that the router R1 facilitates the switching of the ISP with node N without interrupting the connectivity).

With respect to **claim 4**, Ishiyama teaches the method of claim 1, wherein said switching step c) is performed automatically without user knowledge (Ishiyama, page 7,

paragraphs 103-105, noted that the router R1 facilitates the switching of the ISP with node N without interrupting the connectivity).

With respect to **claim 6**, Ishiyama teaches the method of claim 1, wherein said user includes: an individual (Ishiyama, page 4, paragraph 47, noted that node N may be a user), or a group of individuals.

With respect to **claim 7**, Ishiyama teaches the method of claim 1, wherein said service provided to said users over a communications network includes a service provisioning one or more of: text, multimedia content, images, broadcasts, recipes, functions for a computer (Ishiyama, page 3, paragraph 41, enabling communication between server S on the internet and communication node N), and sensory stimulations.

With respect to **claim 8**, Ishiyama teaches the method of claim 1, wherein the switching includes transfer of service properties (Ishiyama, page 7, paragraph 103, noted the same destination address).

With respect to **claim 9**, Ishiyama teaches the method of claim 1, wherein the first and second services are Web services, a service provided by the switching provider including a Web service (Ishiyama, page 3, paragraph 40, noted that ISPa and ISPb).

With respect to **claim 10**, Ishiyama teaches the method of claim 1, where the switching criterion includes one or more selected from the group comprising: said first service provider is unavailable (Ishiyama, page 5, paragraph 64, noted that ISP is unavailable); the service provided by first service provider is degraded (Ishiyama, page 6, paragraph 82, ISPa is disconnected); the cost of the service provided by second

service provider is less than the cost of the service provided by first service provider, the service provided by the second service provider has fewer advertisements, the service provided by second service provider is more secure.

With respect to **claim 12**, Ishiyama teaches the method of claim 1, where the switching criterion is determined based on a potential or predicted relative liability for providing said service (Ishiyama, page 5, paragraph 62, transfer speed).

With respect to **claim 13**, Ishiyama teaches the method of claim 1, where the switching criterion is determined based on one or more of: a relative ease of use for a plurality of users (Ishiyama, page 5, paragraph 62, transfer speed), a relative cognitive load or, the relative occurrence of SPAM.

With respect to **claim 14**, Ishiyama teaches the method of claim 1 where the switching provider comprises one selected from the group comprising: a third party (Ishiyama, fig. 1, router R1), a provider of the first service, a provider of the second service, a provider of both services, a software agent running on the user's computer, a service provider, a company, the government, a video or image content provider, an audio content provider, an insurance agency, a health care provider, an advertiser, a multimedia broadcaster or cable TV company, a game provider.

With respect to **claim 17**, Ishiyama teaches the method of claim 1, where the switching service in a peer-to-peer file sharing system (Ishiyama, fig. 1, Node N and Server S).



Consider **claim 18** the limitations of this claim are substantially the same as those in claim 1. Therefore the same rationale for rejecting claim 1 is used to reject claim 18. By this rationale **claim 18** is rejected.

Consider **claim 19** the limitations of this claim are substantially the same as those in claim 2. Therefore the same rationale for rejecting claim 2 is used to reject claim 19. By this rationale **claim 19** is rejected.

Consider **claim 20** the limitations of this claim are substantially the same as those in claim 3. Therefore the same rationale for rejecting claim 3 is used to reject claim 20. By this rationale **claim 20** is rejected.

Consider **claim 21** the limitations of this claim are substantially the same as those in claim 4. Therefore the same rationale for rejecting claim 4 is used to reject claim 21. By this rationale **claim 21** is rejected.

Consider **claim 23** the limitations of this claim are substantially the same as those in claim 6. Therefore the same rationale for rejecting claim 6 is used to reject claim 23. By this rationale **claim 23** is rejected.

Consider **claim 24** the limitations of this claim are substantially the same as those in claim 7. Therefore the same rationale for rejecting claim 7 is used to reject claim 24. By this rationale **claim 24** is rejected.

Consider **claim 25** the limitations of this claim are substantially the same as those in claim 8. Therefore the same rationale for rejecting claim 8 is used to reject claim 25. By this rationale **claim 25** is rejected.

Consider **claim 26** the limitations of this claim are substantially the same as those in claim 9. Therefore the same rationale for rejecting claim 9 is used to reject claim 26. By this rationale **claim 26** is rejected.

With respect to **claim 27**, Ishiyama teaches the system of claim 18, where the switching criterion includes one or more selected from the group comprising: said first service provider is unavailable (Ishiyama, page 5, paragraph 64, noted that ISP is unavailable); the service provided by first service provider is degraded (Ishiyama, page 6, paragraph 82, ISPa is disconnected); the cost of the service provided by second service provider is less than the cost of the service provided by first service provider; the service provided by the second service provider has fewer advertisements; the service provided by second service provider is more secure; based on a result of an auction system for providing said services; based on a potential or predicted relative liability for providing said service (Ishiyama, page 5, paragraph 62, transfer speed); based on one or more of: a relative ease of use for a plurality of users; a relative cognitive load or, the relative occurrence of SPAM.

Consider **claim 28** the limitations of this claim are substantially the same as those in claim 14. Therefore the same rationale for rejecting claim 14 is used to reject claim 28. By this rationale **claim 28** is rejected.

Consider **claim 31** the limitations of this claim are substantially the same as those in claim 1. Therefore the same rationale for rejecting claim 1 is used to reject claim 31. By this rationale **claim 31** is rejected.

Consider **claim 32** the limitations of this claim are substantially the same as those in claim 2. Therefore the same rationale for rejecting claim 2 is used to reject claim 32. By this rationale **claim 32** is rejected.

Consider **claim 33** the limitations of this claim are substantially the same as those in claim 3. Therefore the same rationale for rejecting claim 3 is used to reject claim 33. By this rationale **claim 33** is rejected.

Consider **claim 34** the limitations of this claim are substantially the same as those in claim 27. Therefore the same rationale for rejecting claim 27 is used to reject claim 34. By this rationale **claim 34** is rejected.

### ***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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13. Claims 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Ishiyama et al. (Publication no.: US 2005/0102415 A1)** in view of **Ito et al. (Publication no.: US 2003/0036921 A1)**.

With respect to claim 3, Ishiyama teaches the method of claim 1, further including the steps of:

establishing criterion for determining service fees (Ishiyama, page 5, paragraph 62, fee) to be charged by a switching service provider for providing said automatic switching (Ishiyama, page 7, paragraphs 103-105, noted that the router R1 facilitates the switching of the ISP with node N without interrupting the connectivity). However, Ishiyama does not explicitly teach a method of communicating fee information to said user.

In the same field of endeavor, Ito teaches a method of communicating fee information to said user (Ito, page 3, paragraph 48, noted that the service fee is displayed to the user).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to incorporate the method of displaying the service fee to the user as taught by Ito in Ishiyama's invention in order to create a friendly interface to the users with the new service provider.

14. Claims 5 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Ishiyama et al. (Publication no.: US 2005/0102415 A1)** in view of Official Notice.

With respect to **claim 5**, Ishiyama teaches a method of automatically performing the switching step c) without the knowledge of the user (Ishiyama, page 7, paragraphs 103-105, noted that the router R1 facilitates the switching of the ISP with node N without interrupting the connectivity). Ishiyama failed to disclose a method of performing the switching step c) at behest of a user. Official Notice is taken that a user interface was well known in a server computer to one of ordinary skill in the art to. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of displaying a user interface to the user for entering a command. The advantage of incorporating this method is to notify the user the change of the service provider and the service fee, thus the user will not be over paying for the service fee.

Consider **claim 22** the limitations of this claim are substantially the same as those in claim 5. Therefore the same rationale for rejecting claim 5 is used to reject claim 22. By this rationale **claim 22** is rejected.

15. **Claim 11** is rejected under 35 U.S.C. 103(a) as being unpatentable over **Ishiyama et al. (Publication no.: US 2005/0102415 A1)** in view of **O'Brien (Patent no.: US 6,587,831 B1)**.

With respect to **claim 11**, Ishiyama teaches all the claimed limitations except that he does not explicitly teach a method of determining a criterion based on a result of an auction system.

In the same field of endeavor, O'Brien teaches a method of determining a criterion based on a result of an auction system (O'Brien, col. 8, lines 2-16).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to incorporate the method of determining a criterion based on a result of an auction system as taught by O'Brien in Ishiyama's invention in as a design pattern for the filter criteria of the switching service.

**16. Claims 15, 16, 29, 30 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishiyama et al. (Publication no.: US 2005/0102415 A1) in view of Frengut et al. (publication no.: US 2002/0046099 A1).**

With respect to **claims 15 and 16**, Ishiyama teaches all the claimed limitations except that he does not explicitly teach a method of generating a fee for switching services based on user satisfaction level. Wherein determining a user satisfaction level according to biometrics obtained from and concerning the user.

In the same field of endeavor, Frengut teaches a method of generating a fee for switching services based on user satisfaction level. Wherein determining a user satisfaction level according to biometrics obtained from and concerning the user (Frengut, page 2, paragraph 26, noted that the service fee is charged after the user is satisfied with user's preference).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to incorporate the method of generating a service fee based on

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the user's preference and satisfaction as taught by Frengut in Ishiyama's invention in order to present a dynamic and customizable interface to the user.

Consider **claims 29 and 30** the limitations of these claims are substantially the same as those in claims 15 and 16. Therefore the same rationale for rejecting claims 15 and 16 is used to reject claim 29 and 30. By this rationale claims 29 and 30 are rejected.

Consider **claim 35** the limitations of this claim are substantially the same as those in claim 15. Therefore the same rationale for rejecting claim 15 is used to reject claim 35. By this rationale claim 35 is rejected.

### ***Conclusion***

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Ballard (Patent no.: 6,078,960) discloses a client-side load-balancing in client server network.
- Traversat et al. (Publication no.: US 2002/0147810 A1) discloses a peer-to-peer resource resolution.
- Sistanizadeh et al. (patent no.: 6,101,182) discloses a universal access multimedia data network.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lin Liu whose telephone number is (571) 270-1447.

The examiner can normally be reached on Monday - Friday, 7:30am - 5:00pm, EST.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Cardone can be reached on (571) 272-3933. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

L.Liu  
06/27/2007

  
JASON CARDONE  
SUPERVISORY PATENT EXAMINER